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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,902	09/28/2001	Makoto Hirota	1232-4775	5673
27123	7590	08/11/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				SHINGLES, KRISTIE D
ART UNIT		PAPER NUMBER		

2141

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

	Application No.	Applicant(s)
	09/966,902	HIROTA, MAKOTO
	Examiner Kristie Shingles	Art Unit 2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 23 May 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-17 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 and 22-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 May 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ .  |

**DETAILED ACTION**

*Response to Amendment*

*Applicant has amended claims 1, 2, 7-12, 17 and 24-29.*

*Claims 18-21 have been canceled.*

*Claims 1-17 and 22-29 are pending.*

*Drawings*

1. The formal drawings and proposed drawing corrections filed 5/23/2005 have been accepted by the Examiner. The corrections to the drawings will not be held in abeyance.

*Specification*

2. The proposed specification corrections filed 5/23/2005 have been accepted by the Examiner. The corrections to the specification will not be held in abeyance.

*Claim Rejections - 35 USC § 101 Utility*

3. Per claims 9, 28 and 29, the proposed statutory-subject-matter correction filed 5/23/2005 has been accepted by the Examiner. Consequently, the 35 U.S.C. 101 rejections have been withdrawn. Correction of the claim language will not be held in abeyance.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1 and 5 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-17 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Tsujimoto* (USPN 6,271,841) in view of *Kubota et al* (USPN 5,754,172).

a. Per claim 1, *Tsujimoto* teaches an information processing system comprising a transmitting apparatus for transmitting news information, and a receiving apparatus communicably connected to said transmitting apparatus for receiving the news information, wherein said receiving apparatus includes:

- voice output means for outputting the content of the received news information as voice in an order predetermined based upon the content of the news information (Abstract, Figure 1, column 3 line 54-column 4 line 4, column 4 line 61-column 5 line 3 and column 7 line 60-column 8 line 23; provision for voice output of news information via signal and speaker); and
- display means for displaying an animation, which imitates a speaking individual, in conformity with the output of said voice (Abstract, Figure 1, column 4 line 5-column 6 line 3, column 7 line 18-column 8 line 23 and column 8 line 54-column 9 line 3; provision for display of animation speaking in synchronization with the voice output of news information).

*Tsujimoto* teaches audio input signals wherein the user could communicate and input commands by vocally (Figure 1, col.2 lines 14-35). Yet, *Tsujimoto* fails to explicitly teach outputting the content of the received new information as voice in an order predetermined for every genre of news information, wherein the genre is capable of being accepted by a designation from a user. However, *Kubota et al* disclose the user selecting an order for outputting the different news genres (Figure 9, col.2 lines 6-65, col.3 lines 19-48, col.4 lines 40-53, col.10 lines 25-52, col.14 lines 4-67, col.15 lines 40-55, col.17 lines 50-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Tsujimoto* and *Kubota et al* for the purpose of provisioning organization and user-friendly preferences to the user, along with designation capabilities for ordering the news data according to their preference and allowing for the designation to be made via voice/audio-input; because it would allow the user to control the sequencing of the news based on their own prioritization scheme.

b. **Claims 2 and 7-9** contain limitations that are substantially equivalent to claim 1 and are therefore rejected on the same basis.

c. **Per claim 11,** *Tsujimoto* teaches an information processing system having a first communication apparatus for transmitting news information, and a second communication apparatus communicably connected to said first communication apparatus for receiving the news information from said first communication apparatus, wherein said second communication apparatus includes:

- voice output means for outputting the content of the received news information as voice (Abstract, Figure 1, column 3 line 54-column 4 line 4, column 4 line 61-column 5 line 3 and column 7 line 60-column 8 line 23; provision for voice output of news information via signal and speaker);
- display means for displaying an animation, which imitates a speaking individual, in conformity with the output of said voice (Abstract, Figure 1, column 4 line 5-column 6 line 3, column 7 line 18-column 8 line 23 and column 8 line 54-column 9 line 3; provision for display of animation speaking in synchronization with the voice output of news information);
- acceptance means for accepting a designation of type of the news information by voice (column 7 line 60-column 8 line 23; acceptance of news weather forecast); and
- notification means for notifying said first communication apparatus of the type of news information designated (column 7 line 60-column 8 line 67; detection and notification of user's preferred news information);
- wherein said first communication apparatus transmits the news information, which belongs to the designated type of which it has been notified by said second communication apparatus, to said second communication apparatus preferentially (column 3 line 54-column 5 line 3 and column 7 line 18-column 8 line 67; news information and audio signals are transmitted from information processor to user's device).

*Tsujimoto* teaches audio input signals wherein the user could communicate and input commands by vocally (Figure 1, col.2 lines 14-35). Yet, *Tsujimoto* fails to explicitly teach outputting the content of the received new information as voice in an order predetermined for every genre of news information, wherein the genre is capable of being accepted by a designation from a user. However, *Kubota et al* disclose the user selecting an order for outputting the different news genres (Figure 9, col.2 lines 6-65, col.3 lines 19-48, col.4 lines 40-53, col.10 lines 25-52, col.11 lines 4-67, col.14 lines 4-67, col.15 lines 40-55, col.17 lines 50-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Tsujimoto* and *Kubota et al* for the purpose of provisioning organization and user-friendly preferences to the user, along with designation capabilities for ordering the news data according to their preference and allowing for the designation to be made via voice/audio-input; because it would allow the user to control the sequencing of the news based on their own prioritization scheme.

- d. **Claims 10, 12, 17 and 24-29** contain limitations that are substantially equivalent to claim 11 and are therefore rejected under the same basis.
- e. **Per claim 3,** *Tsujimoto* and *Kubota et al* teach the apparatus according to claim 2, *Kubota et al* further teach the apparatus, wherein said voice output means outputs the content of the received news information as voice in an order predetermined for every genre of the news information (Abstract, Figure 9, col.2 lines 6-65, col.3 lines 19-48, col.4 lines 40-53, col.10 line 25-col.11 line 44, col.14 lines 4-67, col.15 lines 40-55, col.17 lines 50-56).
- f. **Per claim 4,** *Tsujimoto* and *Kubota et al* teach the apparatus according to claim 2, *Kubota et al* further teach the apparatus, wherein said receiving apparatus receives the news information from said transmitting apparatus periodically; said receiving apparatus further including storage means for storing the received news information; wherein only fresh news information from among the received news information is stored in said storage means (col.4 lines 40-53).
- g. **Claims 13 and 14** are substantially similar to claims 3 and 4 and are therefore rejected under the same basis.

h. **Per claim 5,** *Kubota et al* teach the apparatus according to claim 4, further comprising: means for determining, whenever content of the news information is output by said voice output means, whether fresh news information has been stored in said storage means; and means for determining degree of importance of content of the fresh news information if it is determined that the fresh news information has been stored; wherein said voice output means outputs content of the fresh news information as voice preferentially if the degree of importance of the content of the fresh news information is higher than that of the content of other news information (col.2 line 43-col.3 line 48, col.4 lines 40-62, col.12 line 62-col.13 line 13, col.14 lines 62-67, col.17 lines 57-67).

i. **Per claim 6,** *Tsujimoto* and *Kubota et al* teach the apparatus according to claim 2, *Kubota et al* further teach the apparatus, wherein the order is capable of being set by a user (Figure 9, col.2 line 2-col.3 line 48,col.10 line 41-col.11 line 50, col.15 lines 1-56, col.17 lines 57-67).

j. **Claim 16** is substantially equivalent to claim 6 and is therefore rejected under the same basis.

k. **Per claim 15,** *Kubota et al* teach the apparatus according to claim 14, further comprises means for determining, whenever content of the news information is output by said voice output means, whether the designation of the type of news information has been made; wherein said voice output means outputs content of the news information, which belongs to the type designated, as voice preferentially if the designation has been made (col.4 lines 40-53, col.10 lines 25-52, col.11 lines 45-50, col.12 line 45-col.13 line 12, col.14 lines 2-67, col.15 lines 41-55).

1. **Per claim 22,** *Tsujimoto and Kubota et al* teach the system according to claim 12, wherein said communication apparatus has means for creating a document, which is described by operation description language, that defines processing executed by said display means and said acceptance means, said document incorporating the received news information (col.4 line 35-col.5 line 25, col.8 lines 9-37, col.10 lines 25-40, col.13 line 39-col.14 line 61).

m. **Claim 23** is substantially equivalent to claim 22 and is therefore rejected under the same basis.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Cobbley et al* (USPN 5,614,940), *Menard et al* (USPN 6,061,056), *Gibbon et al* (USPN 6,714,909) and *Shapiro et al* (USPN 6,370,535).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

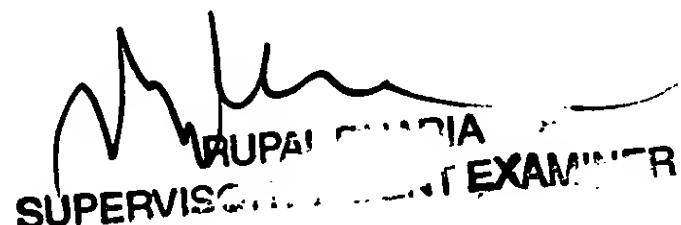
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Kristie Shingles*  
Examiner  
Art Unit 2141

*kds*

  
RUPAL DHARIA  
SUPERVISOR EXAMINER